



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/144,851 09/01/98 KATO

Y KATO=15

001444 IM52/1011
BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON DC 20001-5303

EXAMINER

SHEPHERD, C

ART UNIT

PAPER NUMBER

1761
DATE MAILED:

10/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/144,851

Applicant(s)
Kato et al

Examiner
Curtis E. Sherrer

Art Unit
1761



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 15, 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-31 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 22
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 1761

Part III DETAILED ACTION

Election/Restriction

1. This application contains claims 11 and 20 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 31 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As stated in the last Office Action, Claim 31 contains the limitation of sterilizing and then filtering, and this two step limitation was not found in the specification. Applicants state that the ultrafiltration step provides for a sterilization step because "ultrafiltration removes bacteria." This is not wholly correct, depending on what size ultrafilter used, bacteria may or may not be removed. Further, even if bacteria are removed, viruses can still penetrate a ultrafilter.

Art Unit: 1761

4. Applicants have now amended their claims to recite "or a mixture of plural members" and
specificational basis for this phrase was not given nor found.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

6. Claims 21-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for
failing to particularly point out and distinctly claim the subject matter which applicant regards as
the invention.

7. Claim 21 is indefinite because there is no antecedent basis for the phrase "the not-yet-pH
-adjusted, one member of mixture"

8. Again, there is no antecedent basis for the phrases "the middle stage" and "the last stage,"
as found in Claim 29. Further, the scope of these "stages" is unknown. When does the middle
start?

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness
rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section
102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that
the subject matter as a whole would have been obvious at the time the invention was made to a person having
ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner
in which the invention was made.

10. Claims 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seike in view of Jackson (Wine Science, pp. 229 and 279-80) for the reasons set forth in the last Office Action.

11. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seike in view of Jackson and in further view of Castillon et al (U.S. Pat. No. 5,415,775) for the reasons set forth in the last Office Action.

Response to Arguments

12. Applicant's arguments filed 08/14/01 have been fully considered but they are not persuasive.

13. Applicant argues, with respect to the teachings of the prior art, that Seike does not make the instant claims obvious. Specifically, they state that "It is not the pH per se which interferes with acetic acid fermentation, but, specifically, citric acid." They then state that "the problem with producing vinegars from citrus fruit juices is the presence of the citric acid, which interferes with acetic acid fermentation required to produce vinegar. When the amount of citric acid in the juice is high as exhibited by a pH of less than 3.0 (e.g., 2.50) acetic fermentation does not start and obviously, cannot proceed."

Art Unit: 1761

14. In response, it is first noted that the independent claim broadly is directed to producing a vinegar from juices that have a pH greater than 3.0 and therefore, the above argument is not commensurate in scope with the broadest argument.

15. Secondly, the arguments appear to be of opinion nature and therefore are not convincing. No proof of these assertions is on the record.

16. Applicants also argue that the teaching of Jackson are not combinable with the teachings of Seike because the presence of "citric acid in the juice [] is not a problem in grape juice." Because Jackson is adjusting the pH, and inherently the amounts of acids, to modify the taste of the final product, this teaching is considered to be relevant to the production of wine vinegar, whereby the final acidity of will affect the taste of the vinegar. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

17. Applicants' attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable

Art Unit: 1761

unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

Conclusion

18. No claim is allowed.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner

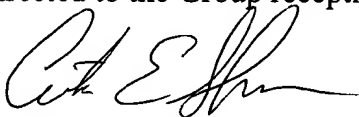
Serial Number: 09/144,851

7

Art Unit: 1761

can normally be reached on Tuesday through Friday from 6:30 to 4:30. The **fax phone number** for this Group is (703)-305-3602.

21. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



Curtis E. Sherrer
Primary Examiner
October 10, 2001